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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,444	10/17/2001	Graham Taylor	0476-2044.1	5834
23644 7590 11/13/2008 BARNES & THORNBURG LLP P.O. BOX 2786 CHICAGO, IL 60690-2786			EXAMINER CHOUDHURY, AZIZUL Q	
			ART UNIT 2445	PAPER NUMBER
			NOTIFICATION DATE 11/13/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent-ch@btlaw.com

### Office Action Summary

**Application No.**

09/981,444

**Applicant(s)**

TAYLOR ET AL.

**Examiner**

AZIZUL CHOUDHURY

**Art Unit**

2445

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 18-20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 18-20 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Detailed Action***

This office action is in response to the correspondence received on August 14, 2008.

***Specification***

The amendment filed 8/14/2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: machine-readable medium comprising a plurality of instructions.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 19, 20 and 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 19, 20 and 22 fail to fall within a statutory category of invention. It is directed to the program itself, not a process occurring as a result of executing the program, a machine programmed to operate in accordance with the program nor a manufacture structurally and functionally interconnected with the program in a manner which enables the program to act as a computer component and realize its functionality. It's also clearly not directed to a composition of matter. Therefore, it's non-statutory under 35 USC 101.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 19, 20 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims cite a machine-readable storage medium however the specifications fail to support such a feature. Appropriate corrections are required.

Claims 19, 20 and 22 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The machine-readable storage medium which is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The machine-readable storage medium is essential because it explains the acceptable mediums within which the claimed invention can be embodied within in a networked computer system.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 recites the limitation "said at least one other entity" in line 7 of claim 1.

There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9, 18-20 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Rajarajan et al (US PG PUB No: US 20020120784A1), hereafter referred to as Rajarajan.

1. With regards to Claims 1, 19, 20 and 22 the Rajarajan discloses: A method comprising: generating structured meta-data providing at least one semantic information element describing a characteristic of each of at least two networked entities (*Rajarajan teaches how hosts (equivalent to at least two networked entities) is described by semantics (which describes a characteristic; see paragraph 4, Rajarajan); see paragraph 35, Rajarajan*); collating the semantic

information elements of each said entity where possible with corresponding semantic information elements of said at least one other entity (*see paragraphs 59 and 61-63, Rajarajan*); analyzing said collated semantic information elements to establish the extent to which the interface capabilities of said at least two networked entities are compatible (*Rajarajan's design teaches how servers are checked to ensure they have proper interfaces with one another; see paragraphs 66-68; Rajarajan*); and generating in accordance with said established compatibility the adaptive software interface for said at least two networked entities (*Rajarajan's design teaches how interfaces are provided (equivalent to the claimed generated) for compatibility; see paragraphs 66-68; Rajarajan*).

2. With respect to Claim 2, the Rajarajan discloses a protocol where entities exchange interfaces via a so-called Lookup Service, thus disclosing: wherein the step of collating occurs dynamically during a preliminary exchange between the two entities prior to an interface being established between the two entities (*equivalent to the initializing of the libraries; see paragraph 57, Rajarajan*).
3. With regards to Claim 3, the Rajarajan discloses said structured meta-data includes associated meta-data for at least one said semantic information element (*see paragraph 53, Rajarajan*).

4. With regards to Claim 4, the Rajarajan discloses the semantic information element describing the characteristics of said adaptive interface is provided in said meta-data in a form independent of the version of software used to generate said metadata (*see paragraph 53, Rajarajan*).
5. With regards to Claim 5, the Rajarajan discloses semantic information compiled into classes by a Java compiler, thus disclosing: wherein said semantic information element is generated by a compiler receiving input data from an interface description and a code template (*see paragraph 40, Rajarajan*).
6. With regards to Claim 6, the Rajarajan discloses said interface description includes a model of the data to be communicated across the interface and a code template (*see paragraph 50, Rajarajan*).
7. With regards to Claim 7, the Rajarajan discloses a protocol that initially registers entity descriptions and interfaces, thus disclosing: wherein said semantic information element provided by said meta-data has a form which can be mapped to an appropriate transport layer and exchanged between said networked entities prior to a higher level interface being established between said networked entities (*equivalent to the initializing of the libraries; see paragraph 57, Rajarajan*).

8. With respect to Claims 8 and 18, the Rajarajan discloses: generating at least one meta-data structure providing at least one semantic information element for each entity, wherein each said semantic information element describes a characteristic of an interface capability of one of said entities (*Rajarajan teaches how hosts (equivalent to at least two networked entities) is described by semantics (which describes a characteristic; see paragraph 4, Rajarajan); see paragraph 35, Rajarajan. The semantics are used in providing interfaces; see paragraphs 65-66, Rajarajan*); collating said meta-data structures such that each semantic information element corresponding to the initiator's interface capability is collated with a corresponding semantic information element corresponding to the responder's interface capability (*see paragraphs 59 and 61-63, Rajarajan*); analyzing the collated semantic information elements to determine the extent to which the initiator and the responder can generate a compatible interface (*Rajarajan's design teaches how servers are checked to ensure they have proper interfaces with one another; see paragraphs 66-68, Rajarajan*); establishing in accordance with said analysis an interface between said initiator and said responder (*Rajarajan's design teaches how interfaces are provided (equivalent to the claimed generated) for compatibility; see paragraphs 66-68, Rajarajan*).
9. With regards to Claim 9, the Rajarajan discloses the meta-data structure is provided in a form suitable for indicating at least one semantic element taken



from the group including: a description, a range, a default value (*see paragraph 62 and it's associated table; Rajarajan*).

### ***Response to Arguments***

Applicant's arguments filed August 14, 2008 have been fully considered but they are not persuasive. The specification amendment submitted within the 8/14/08 amendment has been considered but has been deemed new matter. Therefore, the specifications should be amended back to its original form in the applicant's next response. The following are the examiner's response to the applicant's arguments.

The first point of contention addressed by the applicant concerns the 101 rejection. The applicant has amended the latest claims and contends that the 101 issues have been overcome. The examiner disagrees. Claims 19, 20 and 22 now feature "machine-readable storage medium". However, because the specification amendment submitted on 8/14/08 has been deemed new matter the newly claimed "machine-readable storage medium" is not supported by the specifications. That is why new 101 and 112 rejections have been included to highlight this deficiency.

The second point of contention addressed by the applicant concerns the 112 1<sup>st</sup> paragraph rejection previously issued. The applicant contends that in light of the specification and claim amendments, the claims should have overcome the 112 1<sup>st</sup> paragraph rejection. Unfortunately this is not the case since the specification amendment submitted within the 8/14/08 amendment has been considered but has been deemed new matter. Therefore, the specifications should be amended back to its

original form in the applicant's next response. In addition, since the specifications originally did not provide support for any type of medium, the claimed mediums are not enabled and thus the rejections continue to stand.

The third point of contention addressed by the applicant concerns the claimed "generating an adaptive software interface." The applicant contends that such a limitation is not taught by Rajarajan, the examiner respectfully disagrees. Rajarajan's design teaches how servers are checked to ensure they have proper interfaces with one another; see paragraphs 66-68. The design also teaches how interfaces are provided (equivalent to the claimed generated) for compatibility; see paragraphs 66-68.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AZIZUL CHOUDHURY whose telephone number is (571)272-3909. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. C./  
Examiner, Art Unit 2445

/Jason D Cardone/  
Supervisory Patent Examiner, Art Unit 2445